

REMARKS

Claims 1-23 are pending in this application. Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph. Claims 1, 5-11, and 13 were rejected under 35 U.S.C. §102(e). Claims 2-4, 12, and 14 were rejected under 35 U.S.C. §103. Claims 1-23 were rejected under the judicially created doctrine of obviousness-type double patenting.

By this amendment, claim 1 has been amended without prejudice or disclaimer of any previously claimed subject matter. Support for the amendments can be found, *inter alia*, throughout the specification.

The amendment is made solely to promote prosecution without prejudice or disclaimer of any previously claimed subject matter. With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded subject matter or claim embodiments in one or more future continuation and/or divisional application(s).

Applicants have carefully considered the points raised in the Office Action and believe that the Examiner's concerns have been addressed as described herein, thereby placing this case into condition for allowance.

Assignment

In response to the Examiner's request to be informed of an assignment agreement for the present application, Applicants respectfully point out that the fourth paragraph of the assignment agreement of the parent application, U.S. Serial No. 10/199,662, recites that it also conveys the entire right, title and interest in and to any and all continuations of that application. Thus, the present application, being a continuation of U.S. Serial No. 10/199,662, is assigned to QLT, Inc. This assignment document was recorded October 28, 2002 at reel/frame: 103440/0646.

Rejection under 35 U.S.C. §112, second paragraph

Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although Applicants believe that the claims were sufficiently definite when considered in view of the specification and the understanding of those of skill in the art, Applicants have attempted to respond to the concerns of the Examiner in order to enhance clarity and to facilitate disposition of the present case.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. §102(e)

Claims 1, 5-11, and 13 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Margaron *et al.*, (U.S. Patent Application Publication No. 2003/0083649, “Margaron”). Applicants respectfully traverse this rejection.

The present invention relates to the use of photodynamic therapy (PDT) in the treatment of macular edema. The claimed invention is directed to a method to treat macular edema comprising administering photosensitizer (PS) to a subject afflicted with macular edema and irradiating the macula of the subject with light having a wavelength absorbed by the PS.

Margaron describes the use of low dose PDT for reducing or preventing undesirable inflammation resulting from a previous normal dose PDT treatment. Margaron states that the method can be used to reduce or prevent inflammation caused by normal does PDT treatment of a subject diagnosed or afflicted with various ocular diseases or disorders including diabetic macular edema. See, for example, paragraphs [0010] - [0012]. For the treatment, Margaron describes that

“the area exposed to low dose PDT should overlap with, and sometimes may be, larger than the area exposed radiation under normal dose PDT.” Paragraph [0100].

Margaron, however, does not describe the use of low dose PDT for treating macular edema directly nor does Margaron describe irradiation of the macula for the treatment of macular edema. For a claim to be anticipated by a reference, the reference must teach each and every element of the claim. Thus, Applicants respectfully submit that Margaron does not anticipate the claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(e).

Rejection under 35 U.S.C. §103(a)

Claims 2-4, 12 and 14 were rejected under 35 U.S.C. §103 as allegedly unpatentable over Margaron. Applicants respectfully traverse this rejection.

The Examiner noted on page 2 of the Office Action that the application of Margaron is assigned to QLT, Inc. As Applicants outlined above, the present application is also assigned to QLT, Inc. Thus, according to 35 U.S.C. §103(c), the §102(e) reference of Margaron shall not preclude patentability under 35 U.S.C. §103. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

Rejection Under Obviousness-Type Double Patenting

Claims 1-23 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-31 of U.S. Patent No. 6,599,891.

Submitted herewith is a terminal disclaimer for the instant application with regard to U.S. Patent No. 6,599,891.

Accordingly, Applicants respectfully request withdrawal of this rejection.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 273012013101. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By Karen R Zachow
Karen Zachow, Ph.D.

Registration No.: 46,332
MORRISON & FOERSTER LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130
(858) 720-5191